

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

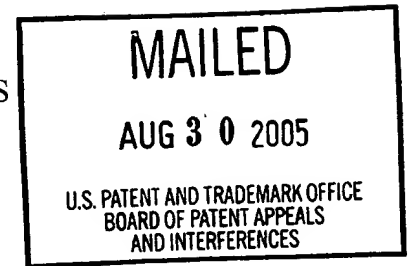
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY M. GARIBALDI
and WALTER M. BLUME

Appeal No. 2005-2071
Application 09/200,055

ON BRIEF



Before WARREN, WALTZ and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejections advanced on appeal: appealed claims 3, 9, 15, 16, 19, 26, 30, 34 through 38, 41 and 42 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Anderson (final action mailed December 31, 2001 (hereinafter final action), pages 1-4); appealed claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Anderson (final action, 4); and appealed claims 3, 9, 15, 16, 19, 26 and 30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 18 of United States Patent

5,931,818 to Werp et al. (Werp) (*id.*, pages 5).^{1,2,3}

The alternative grounds of rejection under §§ 102(b) and 103(a) require separate consideration under each statutory provision. *See generally, In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990).

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697,

¹ Appealed claims 3, 9, 15, 16, 19, 26, 27, 30, 34 through 38, 41 and 42 are all of the claims in the application. See the appendix to the brief.

² The examiner states that the first and third grounds of rejection are set forth in the Office action mailed December 31, 2001. We have brought forward the second ground of rejection because there is no statement in the answer that this ground is withdrawn; the examiner considers appellants' statement of the issues containing this ground to be correct; appealed claim 42, dependent on claim 27, is rejected in the first ground of rejection; and the issues raised in the second ground are addressed in the answer (page 7), the brief (pages 10-11) and reply brief (pages 5-6). *See Manual of Patent Examining Procedure* § 1208 (8th ed., Rev. 2, May 2004; 1200-16 – 1200-17) ("Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so.").

³ The examiner withdraws the third ground of rejection with respect to appealed claims 16, 34 through 37, 41 and 42 (answer, page 3). The examiner did not include appealed claim 27 in the statement of this rejection in the answer, and we will not bring the rejection of this claim forward from the final action mailed December 31, 2001, because this claim is directed to the same invention as the appealed claims no longer included in this ground of rejection.

1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein “is within the knowledge of the skilled artisan.”); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”). It is also well settled that in order to establish that a claim element is inherent in a single prior art reference, it must be established that such limitation is necessarily present in the description in the reference and that it would be recognized as such by one skilled in the art, as “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.]” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *see also Transclean Corp. v. Bridgwood Serv., Inc.*, 290 F.3d 1364, 1372-73, 62 USPQ2d 1865, 1870-71 (Fed. Cir. 2002); *MEHL/Biophile Int’l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); *Robertson*, 169 F.3d at 745, 49 USPQ2d at 1950-51; *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991); *King*, 801 F.2d at 1326, 231 USPQ at 138.

In order to establish a *prima facie* case of obviousness, the examiner must, in the first instance, show that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claim arranged as required therein, without recourse to the teachings in appellants’ disclosure. *See generally, In re Thrift*, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002); *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of the reference. *See*

B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). An examiner’s unsupported allegations with respect to knowledge in the prior art does not provide substantial evidence of such suggestion or motivation, particularly in light of a challenge thereof by appellants. *See In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970) (notice may be taken “of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute”); *see also Rouffet*, 149 F.3d at 1358, 47 USPQ2d at 1458 (“hindsight” is inferred when the specific understanding or principle within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained).

The principal issue in this appeal is whether there is substantial evidence in the record supporting the examiner’s position that the claimed invention encompassed by appealed claims 3, 9, 15, 19, 26 and 30 and by appealed claims 16, 27, 34 through 37, 41 and 42 is described to one skilled in the art by Anderson within the meaning of § 102(b), and would have been obvious to one of ordinary skill in this art over Anderson alone.

As an initial matter, we interpret the language of the appealed claims by giving the claim terms the broadest reasonable interpretation in ordinary usage as it would be understood by one of ordinary skill in the art in light of the written description in the specification as interpreted by this person, and without reading into the claims any limitation or particular embodiment disclosed in the specification. *See, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). We agree with appellants that the term “flexible” in the claim language “flexible magnetic material” specified in independent claims 3, 9, 15 and 26, must be given its ordinary meaning and in context modifies the term “magnetic material” (reply brief, pages 2-4). Thus, the “magnetic material” must be inherently “flexible” as a whole, as illustrated in specification **FIGs. 13 and 13a**, which is not the flexibility impart by segmenting a piece of magnetic material so that the segments articulate with each other, as illustrated in Anderson **FIG. 11** (col. 7, ll. 19-30). We also agree with appellants (reply brief, pages 5-6) that in the claim language “in spaced apart

relation” specified in independent claims 16, 27 and 34, the term “spaced apart relation” in context requires that there must be some distance, however small, between the magnets in the distal tip on the distal end of the guide wire in claim 27, and that there must be sufficient distance between the magnets “to allow the guide wire to assume a shape under the control of the magnetic field,” that is, “shape the magnetic tip in the desired configuration,” in claim 16, with the similar language in claim 34 interpreted in the same manner.

We find that the examiner’s unsupported discussions on “understanding magnets and their properties” in the final action (pages 2-3) and the answer (pages 4-7) does not, on this record, evince knowledge in the art establishing that one skilled in this art would find in Anderson a description of a stylet or guide wire having the “flexible magnetic material” encompassed by appealed claims 3, 9, 15 and 26, or that one of ordinary skill in this art would have thus modified Anderson by using “flexible magnetic material” in the stylet or guide wire of the reference as required by these appealed claims. We find that Anderson discloses that “[o]ne reason why this invention is now practical is due to the development of extremely high magnetic material such as cobalt and the like” (col. 7, ll. 31-34). In this respect, we find that the magnetic materials neodymium-iron-boron and samarium cobalt disclosed in appellants’ specification (e.g., page 10, ll. 16-17) relied on by the examiner “as two suitable materials that Applicant considers to be flexible magnetic materials”(answer, page 4) are not so disclosed by appellants, the magnetic materials steel and stainless steel wire and braid disclosed in this respect (specification, e.g., page 14, ll. 1-9; reply brief, pages 2-3). Thus, the examiner has not established that one skilled in the art would recognize that the “cobalt and the like” magnets described by Anderson are necessarily inherently “flexible magnetic material” as claimed, or that the disclosure of such magnetic material by the reference would have reasonably suggested the use of “flexible magnetic material” to one of ordinary skill in this art. Furthermore, the examiner’s alternative position that Anderson teaches a “grouping of magnets that is collectively flexible” (answer, pages 6-7) also does not describe and would not have suggested the claimed “flexible magnetic material” as we have interpreted this claim language above.

Accordingly, we find that the examiner has not established a *prima facie* case of anticipation as a matter of fact or a *prima facie* case of obviousness as a matter of law with

respect to appealed claims 3, 9, 15, 19, 26 and 30 under 35 U.S.C. §§ 102(b) and 103(a), respectively, and thus we reverse the grounds of rejection of these claims under these statutory provisions.

We further find that, as appellants point out (brief, pages 9-11; reply brief, pages 5-6) and contrary to the examiner's position (final action, page 4; answer, page 7), the magnet illustrated in Anderson **FIG. 11** are not "in spaced apart relation" as required in claims 16, 27 and 34. Indeed, Anderson discloses that the plural "magnets do not totally part from each other because of the extreme force exerted between them, . . . [but] may partially separate as illustrated in FIG. 11," and that in this embodiment, "the small magnets . . . function as one magnet, but articulate with each other" (col. 7, ll. 19-30). The examiner has thus not established that one skilled or one of ordinary skill in this art would find or would have found in this disclosure of Anderson that the plural magnets are necessarily inherently in a "spaced apart relation" as required by claims 16, 27 and 34. Furthermore, the examiner's position that at the time the claimed invention was made, one of ordinary skill in this art would have been motivated to use multiple magnetic means in the distal end of the stylet or guide wire of Anderson is not established by the unsupported allegation that this person would have routinely duplicated magnetic means on a stylet or guide wire "for purposes of creating a region of increased angularity" (final action, page 4). *See generally, Rouffet*, 149 F.3d at 1358, 47 USPQ2d at 1458.

Accordingly, we find that the examiner has not established a *prima facie* case of anticipation as a matter of fact or a *prima facie* case of obviousness as a matter of law with respect to appealed claims 16, 34 through 37, 41 and 42 under 35 U.S.C. §§ 102(b) and 103(a), respectively, and a *prima facie* case of obviousness as a matter of law with respect to appealed claim 27, and thus we reverse the grounds of rejection of these claims under these statutory provisions.

The issue raised in the ground of rejection under the judicially created doctrine of obviousness-type double patenting is whether the claimed invention encompassed by appealed claims 3, 9, 15, 16, 19, 26 and 30 is an obvious variation of the claimed invention encompassed by patent claims 1 through 18 of Werp. *See generally, In re Emert*, 124 F.3d 1458, 1461-62, 44 USPQ2d 1149, 1152-53 (Fed. Cir. 1997). In stating the ground of rejection, the examiner

does not set forth the basis for holding that “a magnet means attached to the distal end of the stylet” or guide wire renders the appealed claims requiring “a flexible magnetic material” obvious in view of the patent claims requiring “a magnet” or a “magnetic tip” (final action, page 5). In response to appellants’ argument that the claims of Werp do not suggest or make obvious the claimed invention requiring “a flexible magnetic material” encompassed by the appealed claims (brief, pages 11-12), the examiner points out that Werp discloses neodymium-iron-boron as a magnetic material and refers to the position advanced in the answer that neodymium-iron-boron is a flexible magnetic material (page 8). The examiner can, of course, rely on the disclosure of a patent to interpret the language of the claims therein. *See generally, In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). However, as we have discussed (*see above* p. 5), the examiner has not established on this record that neodymium-iron-boron is in fact “a flexible magnetic material” (*see* reply brief, pages 6-7). Thus, we find no evidence in the record establishing that, *prima facie*, the terms “a magnet” and “magnetic tip” used by Werp would have been considered by one of ordinary skill in this art to encompass or suggest “a flexible magnetic material.” Indeed, on this record, the relationship between the term “a flexible magnetic material” and the terms “a magnet” and “magnetic tip” is not one of an established species of an established genus. *Cf. Vogel*, 422 F.2d at 442-43, 164 USPQ at 622-23.

Accordingly, we determine that the examiner has not established a *prima facie* case of obviousness-type double patenting over the claims of Werp, and thus we reverse the grounds of rejection of claims 3, 9, 15, 16, 19, 26 and 30 under this judicially created doctrine.

The examiner’s decision is reversed.

Appeal No. 2005-2071
Application 09/200,055

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